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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,538	12/01/2000	Peter B. Reintjes	P00044702	5338

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EXAMINER

CHANG, JON CARLTON

ART UNIT PAPER NUMBER

2623

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,538

Applicant(s)

REINTJES ET AL.

Examiner

Jon Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-36 is/are allowed.
- 6) ☒ Claim(s) 1-3, 14-17 and 27 is/are rejected.
- 7) ☒ Claim(s) 4-13, 18-26 and 28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication US2002/0146170 A1 to Rom.

Regarding claim 1, Rom discloses a system for automatically identifying a form or a page in multi-page form comprising:

digitizing pen (paragraph [0017], lines 5-7);

a digitizing tablet (paragraph [0017]), further comprising

a support surface for supporting a form (paragraph [0017], lines 11-13); and

means to detect pen stroke data when the digitizing pen is used to enter data in data entry fields on the form placed on the support surface, said pen stroke data having content information that is information requested by the form and location information that indicates the location on the form where the pen stroke data was entered (paragraph [0016], lines 11-12); and

form selection means to select an electronic image of the form which data was entered on by the digitizing pen by selecting the best match of the pen stroke data with

the electronic images of the forms (paragraph [0024]; the form templates are electronic images of the forms);

whereby the system can be used to automatically identify the form being used based on the pen stroke data (see abstract).

As to claim 2, Rom discloses a system, as in claim 1, wherein Rob discloses the form selection means compares the location information from the pen stroke data with the location of data entry fields on forms, and selects the electronic image of the form related to the form on which the data was entered by selecting the best match of the location information with the location of the data entry fields on the electronic images of the forms (paragraph [0016], lines 10-13);

whereby the electronic form image is selected by determining the location of data entered on the form (abstract).

Regarding claim 3, Rom discloses a system, as in claim 2, wherein:

each form used by the system has data entry fields in different locations on the form (paragraph [0016], lines 6-8); and

the form selection means distinguishes between forms by comparing the location information in the pen stroke data with the unique location of data entry fields on individual forms (paragraph [0016], lines 11-13);

whereby the selection of an electronic image of a form is made more fault tolerant by placement of data entry fields on different forms in disparate locations (it is inherent that the data entry fields on different forms are in disparate locations because form identification is based on the field locations. If the fields were in the same

locations on different forms, the system could not distinguish the different forms based on location.).

Regarding claim 15, Rom disclose a method of automatically identifying a form or a page in multi-page form, including the steps of:

using a digitizing pen and a digitizing tablet to generate pen stroke data when data is entered in data entry fields on a form (paragraph [0017]); and

using the pen stroke data to select an electronic image of the form on which the pen stroke data was entered by selecting the best match of the pen stroke data with data entry fields on the electronic images of the forms (paragraphs [0016] and [0024]);

whereby the system can be used to automatically identify the form being used based on the pen stroke data (abstract).

As to claims 16-17, see the discussion above for claims 2-3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rom and U.S. Patent 6,259,043 to Clary et al. (hereinafter "Clary").

With regard to claim 14, Rom does not disclose the limitations of claim 14.

However, these are well known as evidenced by Clary. Clary discloses:

form selection means determines whether the content information from the pen stroke data contains content identifiable data unique to a particular form, and selects the electronic image of the form related to the form on which the data was entered when content identifiable data is present (column 6, lines 39-46);

whereby the electronic form image is selected by detecting that content identifiable data was entered on the form (column 6, lines 39-46).

Utilizing content identifiable data unique to a particular form provides improved form identification, since the data would correspond to one form type.. Therefore, it would have been obvious to one of ordinary skill in the art to modify Rom's invention according to Clary.

Regarding claim 27, remarks similar to those provided above for claim 14 are applicable.

Allowable Subject Matter

6. Claims 29-36 are allowed.
7. Claims 4-13, 18-26 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

References Cited

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,243,149 to Comerford et al. teaches a clipboard with a stylus digitizer which can identify a form utilized a printed bar code on the form.

U.S. Patent 5,587,560 to Crooks et al. teaches a portable handwritten data capture device which allows a user to write on a paper slip.

U.S. Patent 5,627,349 to Shetye et al. teaches an interactive data entry apparatus including a digitizer which can determine the type of form being used. The apparatus includes a photo-detector array which optically reads digitally encoded information from the form.

U.S. patent 5,629,499 to Flickinger et al. teaches an electronic board which stores information written on a paper form on top of the board. The clip on the board includes a bar-code reader.

U.S. Patent 5,743,129 to Belville et al. teaches forms for use with handwriting capturing device.

U.S. Patent 6,050,490 to Leichner et al. teaches a digital electronic clipboard which allows mounting of forms, and which combines an image of the form with entered stylus data.


U.S. Patent 6,456,740 to Carini et al. discloses a system and method for identifying form type in a handwriting recognition based form completion sheet. In the patent, the forms are electronic.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Chang whose telephone number is (703)305-8439. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703)308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.


Jon Chang
Primary Examiner
Art Unit 2623

Jon Chang
September 22, 2003